

REMARKS

Claims 1-19 are pending in this application. By the Office Action, claims 10-19 are withdrawn from consideration; claims 1-4 and 6-9 are rejected under 35 U.S.C. §102; and claim 5 is rejected under 35 U.S.C. §103. By this Amendment, claim 1 is amended. Support for the amendments to claim 1 can be found, for example, in the specification as filed at page 11, lines 11-33. No new matter is added.

I. Restriction and Election of Species Requirements

Claims 1-19 are subject to a Restriction (lack of unity of invention) and Election of Species Requirements. Claims 10-19 are withdrawn from consideration. Applicant respectfully traverses the Requirements.

A. The Restriction Requirement is Improper

Applicant respectfully asserts that the Requirement is improper under the rules of practice in PCT national phase applications, because the appropriate unity of invention standards have not been properly applied by the Patent Office. In PCT national phase applications, the Examiner may issue a restriction-type Requirement if no unity of invention exists. However, the Examiner must state why there is no "single general inventive concept." See MPEP §1893.03(d). Therefore, a single application may include one invention, or more than one invention if the inventions are "linked as to form a single general inventive concept." Id. (emphasis added). If multiple inventions are included in the application, they are deemed to be linked if there exists a "technical relationship among the inventions that involves at least one common or corresponding special technical feature." Id.

The Office Action asserts that unity of invention does not exist, because Groups I is directed to an optical member, and Group II is directed to a process for producing an optical member. In the present application, the special technical feature which is common between the three groups of claims is the optical member of claim 1. This optical member forms the product

of Group I (claims 1-17), and is produced by the process of Group II (claims 18-19). Under the PCT rules of practice, unity of invention exists because this special technical feature is common to both groups of claims, and therefore a Restriction Requirement is improper. The Examiner's attention is also directed to Annex B, Part 2, of the PCT Administrative Instructions (MPEP Appendix AI) wherein unity of invention is demonstrated between a method of making Compound X, Compound X, and a method of using Compound X (Example 1). This Example further demonstrate that Groups I-II posses unity of invention and should not be subject to a Restriction Requirement.

Because the Examiner has not properly demonstrated an absence of unity of invention under the rules, the Restriction Requirement is improper. Reconsideration and withdrawal of the Restriction Requirement are respectfully solicited.

B. Rejoinder Will Be Required

In any event, rejoinder of the non-elected claims will be required, and thus the Restriction Requirement should be withdrawn.

Where product and process claims are presented in the same application, Applicant may be called upon under 35 U.S.C. §121 to elect claims to either the product or process. MPEP §821.04. However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim. Id.

In the present application, the method claims of Group II include all of the limitations of the product of Group I. In particular, all of the limitations of the independent product claim 1 of Group I are incorporated into the method of Group II.

Since the method claims of Group II include the limitations of the product claims of Group I, the method claims must be rejoined with the product claims once the product claims are allowed. Thus, to streamline prosecution and avoid delay, the Restriction Requirement

should be withdrawn to permit concurrent examination of all of the pending claims. Applicant respectfully requests reconsideration and withdrawal of the Restriction Requirement.

C. The Election of Species Is Improper

Applicant also respectfully submits that the Election of Species Requirement is improper, and should be withdrawn.

Although Species I and II may include different limitations, the subject matter of Species I and II is sufficiently related that a search of any one Species would encompass a search of the subject matter of the remaining Species. That is, a search for Species I would encompass a search for Species II. The prior art revealed by a search of any Species would overlap the prior art revealed by a search of the remaining Species. Applicant respectfully submits that there would be no serious burden on the Patent Office to examine all of the present claims because the subject matter of Species I and II is sufficiently related that a search of any one group would encompass the search of the subject matter of the remaining groups. Thus, the Election of Species Requirement is improper and should be withdrawn.

II. Rejection Under 35 U.S.C. §102

Claims 1-4 and 6-9 are rejected under 35 U.S.C. §102(b) as being anticipated by Ono. Applicant respectfully traverses the rejection.

Claim 1, as amended, is directed to an optical member having planes of incidence and emergence, comprising: an optical element that changes an optical path of incident light, the optical element being formed on at least one of the planes of incidence and emergence, wherein a predetermined part of the optical member, selected from the planes of incidence and emergence, has a plurality of minute concavities by which reflection of light incident on the predetermined part is prevented, and wherein the optical member is formed by casting a molding resin upon a surface of a mold and by curing the molding resin, the surface of the

mold having formed thereon a plurality of minute protrusions in a shape that is a reverse of a shape of the plurality of minute concavities. Such an optical member is not disclosed in Ono.

Ono describes a Fresnel lens sheet used for tooth-back projection form television, and a method for manufacturing such a sheet. See translation at paragraph [0001]. According to Ono, the Fresnel lens sheet has an irregular concave-convex front face, having 1-100 irregularities (e.g., concavities) per square micron with 0.2-0.7 micron distance between adjoining concavities and a depth of concavities of 0.05-0.2 microns. See translation at paragraph [0010]. The Fresnel lens sheet of Ono is made by a spin-coating process. See translation at paragraph [0012].

In contrast to Ono, amended claim 1 specifically requires that the optical member is formed by casting a molding resin upon a surface of a mold and by curing the molding resin, the surface of the mold having formed thereon a plurality of minute protrusions in a shape that is a reverse of a shape of the plurality of minute concavities. Although this may be a process limitation in the product claim, the process results in a different product from a similar product made by spin coating (as in Ono), and thus gives patentable weight to the claim and differentiates the claimed invention over Ono.

In particular, as described in the present specification, the mold casting method required by claim 1 provides an advantageous effect and different product properties to the optical member, which effects are not provided in an optical member made by spin coating as in Ono. For example, using conventional methods such as spin coating, it is very difficult to form a low refractive index layer on the surface of an optical member, and any such low refractive index layers thus formed by the conventional processes generally have undesired irregularities.¹ Such irregularities are particularly undesired in many applications, such as

¹ These irregularities are defects, as opposed to the desired concavities that are referred to in the Ono translation as "irregularities."

projection screens, as they do not provide the desired high image quality. Furthermore, the conventional processes such as spin coating are more cost intensive processes, which can not as easily be scaled up to commercial scale. These differences together mean that the conventional processes such as spin coating not only can not be used to provide high quality low refractive index sheets without irregularities, but the processes can not be used commercially at high quality levels. See specification at page 2, lines 7-19.

Accordingly, the claimed process limitation in amended claim 1 not only allows commercial scale production, which is not possible using the processes of Ono, but also provides a higher quality product. Whereas Ono would provide a sheet having defect irregularities, such defect irregularities are reduced or eliminated by means of the claimed invention.

Because Ono does not teach all of the limitations of the claimed invention, the claims are patentable over Ono. Reconsideration and withdrawal of the rejection are respectfully requested.

III. Rejection Under 35 U.S.C. §102

Claim 5 is rejected under 35 U.S.C. §103(a) as having been obvious over Ono in view of van de Ven. Applicant respectfully traverses the rejection.

Claim 1 and Ono are described above. As described, claim 1 requires that the optical member is formed by casting a molding resin upon a surface of a mold and by curing the molding resin, the surface of the mold having formed thereon a plurality of minute protrusions in a shape that is a reverse of a shape of the plurality of minute concavities. As a result of this limitation, the claimed invention provides an optical member that can be more easily prepared on a commercial scale, which is not possible using the processes of Ono, and that has a higher quality (less defect irregularities) than the product of Ono. Whereas Ono

would provide a sheet having defect irregularities, such defect irregularities are reduced or eliminated by means of the claimed invention.

Ono nowhere teaches or suggests that such product differences could or should be achieved by using a mold casting method, rather than Ono's described spin coating. Ono thus nowhere teaches or suggests that the described product and process could or should be modified so as to achieve the claimed invention.

Van de Ven does not overcome the deficiencies of Ono. Van de Ven is cited for its alleged disclosure of an optical member, where a laminar portion including with the concavities has a percentage of void of 20 to 50%. However, regardless of whether van de Ven includes such disclosure, van de Ven fails to teach or suggest that Ono could or should be modified by changing the spin coating method to a mold casting method, and fails to teach or suggest that such changes would provide a product that can be made on a commercial scale and without defect irregularities that are present in Ono.

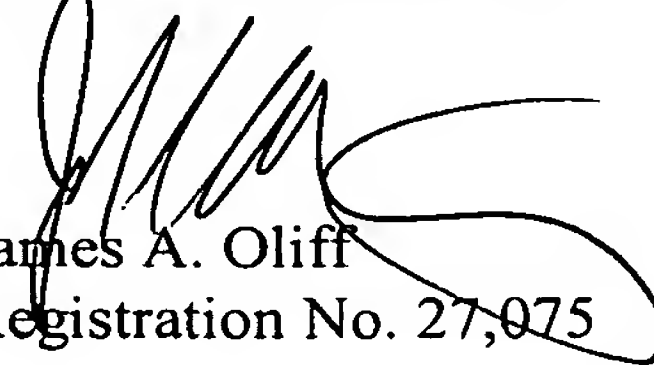
Because Ono and van de Ven do not teach or suggest all of the limitations of the claimed invention, the claims are patentable over Ono in view of van de Ven. Reconsideration and withdrawal of the rejection are respectfully requested.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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